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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,912	12/07/2006	Kenji Yamaguchi	050827	3804
25225 7590 06/30/2009 MORRISON & FOERSTER LLP 12531 HIGH BLUFF DRIVE SUITE 100 SAN DIEGO, CA 92130-2040				
EXAMINER MAGLOIRE, VLADIMIR				
ART UNIT 2617		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/562,912

**Applicant(s)**

YAMAGUCHI, KENJI

**Examiner**

VLADIMIR MAGLOIRE

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Response to Arguments***

1. Applicant's arguments with respect to claims 1 to 13 have been considered but are moot in view of the new ground(s) of rejection.
2. Please note that claim 1, is rejected under 35 USC 102b and 35 USC 103a.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Regarding claim 1, the phrase "operable to" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Satoh (EP 0881 587 A2).

Consider claim 1, Satoh discloses a terminal device for transmitting and receiving mails (see Satoh, fig. 1 item 15, fig. 2 item 220), comprising: a mail receiving unit (see Satoh, fig. 2 item 220); a judging unit operable to judge whether a command declaration is included in a received mail (see Satoh, fig. 1 item 1, fig. 9 item 413,

**page 10 lines 46 to 47);** a command interpreting unit operable to extract and interpret a specific command following the command declaration if the judgment of the judging unit is affirmative **(see Satoh, fig. 1 item 1, fig. 9 item 413, page 10 lines 46 to 47, page 11 lines 4 to 33);** a creating unit operable to create, if the specific command is interpreted as target list creation, a list of corresponding targets in memory of the terminal device **(see Satoh, page 10 lines 49 to 57, fig. 8 items 300-330);** and a mail transmitting unit operable to create and transmit a mail having confirmation of the executed commands as a mail body and addressed to the requester **(see Satoh, fig. 8, discloses an email request, item 300, and the subsequent response, item 330, with the target list).**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7, 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Heureux (US 6,697,942 B1) (hereafter "Heureux") in view of Satoh (EP 0881 587 A2).

Consider claim 1, Heureux discloses a terminal device for transmitting and receiving mails **(see Heureux, fig. 1 items 110, 150, Col 4 lines 53 to 60, Col 5 lines 2 to 1, Col 6 lines 39 to 43),** comprising: a mail receiving unit **(see Heureux, Col 5 lines 25 to 39, fig. 3);** a judging unit operable to judge whether a command declaration is included in a received mail **(see Heureux, Col 8 lines 4 to 6);** a command

interpreting unit operable to extract and interpret a specific command following the command declaration if the judgment of the judging unit is affirmative (**see Heureux, Col 8 lines 5 to 14**); a creating unit operable to create, if the specific command is interpreted as target list creation, a list of corresponding targets in memory of the terminal device (**see Heureux, fig. 8, Col 10 lines 51 to 67, creating a list of new address entries**); and a mail transmitting unit operable to create and transmit a mail having confirmation of the executed commands as a mail body and addressed to the requester (**see Heureux, fig. 2 item 230, Col 8 lines 45 to 50**).

Heureux does not specifically disclose the created list as a mail main body and addressed to a requester.

Satoh discloses the created list as a mail main body and addressed to a requester (**see Satoh, fig. 8, discloses an email request, item 300, and the subsequent response, item 330, with the target list**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Heureux by changing the email confirmation response to include the created list as a mail main body and addressed to a requester, as taught by Satoh, thereby providing the user with broader control of remote operations (see Satoh, page 2, lines 39 to 57).

Consider claim 2, the terminal device of claim 1, further comprising: a comparing unit operable to detect, if a password accompanies the command declaration and the judgment of the judging unit is affirmative, the password, and compare the password with a password owned by the terminal device; and an authorizing unit operable to

authorize the extraction and interpretation of the specific command if the passwords match each other (**see Heureux, Col 7 lines 60 to 67, Col 12 lines 56 to 60, Col 13 lines 4 to 15**).

Consider claim 3, the terminal device of claim 1, wherein the command declaration is a unique character string different from a mail text, and the specific command is a line of code including a storage location of the targets, a type of the targets, and a process to be performed (**see Heureux, fig. 4 item 410, 450, 460, fig. 8, 9**).

Consider claim 4, the terminal device of claim 3, wherein the targets are received mails, transmitted mails, schedules of events, images, telephone numbers, received voice calls, or transmitted voice calls (**see Heureux, fig. 8, 9**).

Consider claim 5, the terminal device of claim 1, Heureux does not specifically disclose wherein if a specific command transmitted by the requestor after the requestor checks the list of the mail is a request of transmitting a specific item in the list, the specific item is read from the memory, and a mail having the read specific item as a mail main body and addressed to the requestor is created and transmitted.

Satoh discloses if a specific command transmitted by the requestor after the requestor checks the list of the mail is a request of transmitting a specific item in the list, the specific item is read from the memory, and a mail having the read specific item as a mail main body and addressed to the requestor is created and transmitted (**see Satoh, fig. 8, item 300 discloses a request for a list stored in a specific memory location,**

**item 310 "C:YSALESYREPORT1.TXT", which is then transmitted backed to the requestor in the main body of email as shown in item 330).**

Motivation for combining was shown in claim 1.

Consider claim 6, the terminal device of claim 1, wherein if a specific command transmitted by the requestor after the requestor checks the list of the mail is a request of deleting a specific item in the list, the specific item is deleted from the memory **(see Heureux, fig. 8 item "add/change entry in address book").**

Consider claim 7, the terminal device of claim 6, wherein a mail having a main body which indicates completion of the deletion and addressed to the requestor is created and transmitted **(see Heureux, Col 8 lines 42 to 53).**

Consider claim 9, the terminal device of claim 1, wherein if the targets are schedules of events, a date, a time, and an icon indicating a type of an event are displayed in the list, with respect to each of the schedules of events **(examiner takes official notice that providing event time, date and image of an event was well known at the time of the invention).**

Consider claim 10, the terminal device of claim 1, wherein if the targets are images, a shooting date, a title, an address in which an image is stored are displayed in the list, with respect to each of the images **(examiner takes official notice that providing image time, title, and storage location of an image was well known at the time of the invention).**

Consider claim 11, the terminal device of claim 1, being a mobile phone (**see Heureux, Col 14 lines 56 to 63, discloses the target may be any terminal device with a CPU**).

Consider claim 12, the terminal device of claim 2, wherein the command declaration is a unique character string different from a mail text, and the specific command is a line of code including a storage location of the targets, a type of the targets, and a process to be performed (**see Heureux, fig. 8,9**).

Consider claim 13, the terminal device of claim 12, wherein the targets are received mails, transmitted mails, schedules of events, images, telephone numbers, received voice calls, or transmitted voice calls (**see Heureux, fig. 8, 9**).

6. Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over L'Heureux (US 6,697,942 B1) (hereafter "Heureux") in view of Satoh (EP 0881 587 A2) further in view of Day (US 2003/0224760 A1).

Consider claim 8, the terminal device of claim 1, the combination of Heureux and Satoh do not specifically disclose if the targets are received mails, at least a sender, a received date, and a subject are displayed in the list, with respect to each of the received mails.

Day discloses if the targets are received mails, at least a sender, a received date, and a subject are displayed in the list, with respect to each of the received mails (**see Day, paragraphs [0037-0039], discloses providing a list with the sender, received date and subject with respect to each received email**).



Providing a list of received emails, with the associated sender, subject and date was a well known technique at the time of the invention, therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Heureux and Satoh by adding details of received emails to the list of retrieved files, as taught by Day, thereby allowing greater user flexibility (see Day, paragraph [0005]).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VLADIMIR MAGLOIRE whose telephone number is (571)270-5144. The examiner can normally be reached on Monday to Thursday, 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro can be reached on 571-272-7876. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NICK CORSARO/  
Supervisory Patent Examiner, Art Unit 2617

/Mladimir Magloire/  
Examiner, Art Unit 2617 6/24/09